

REMARKS

Claims 1-68 are pending in the application.

Claims 1-68 stand rejected.

In a telephone conference with the Examiner's supervisor, Andrew Fischer, he stated that the December 21, 2007 Office Action did have a three month period for response. Additionally, Mr. Fischer stated that Applicants could incorporate by reference the Amendment they filed on April 26, 2007 in response to the Decision On Appeal, and separate that response from Applicants' assertions and traversals to the rejections in the December 21, 2007 Office Action that were made by the Examiner in addition to those made by the Appeal Board. As a result, in the following paragraphs, Applicants have separated their arguments and traversals between these two groups.

Notwithstanding the foregoing, Applicants respectfully assert that the Examiner should not have basically passed Applicants' traversals back to the Board and issued new rejections of the claims not rejected by the Board. Since the Board had reversed the previous Examiner's rejections, and not issued new rejections on claims 19-23, 25-45, 51-53, and 54-62, those claims stood allowed. This Examiner has not issued rejections of those claims. The problem is that such rejections are not new, but are exact copies of previous rejections issued on December 3, 2003. This is not proper under MPEP §706.04 as further pointed out below.

With all due respect, this application, and particularly these Applicants, have suffered enough delay and expense, and it is immensely unfair to have to fight old and conquered rejections again.

Applicants acknowledge that the Amendment filed on April 26, 2007 will be entered with respect to the claim amendments responding to the 35 U.S.C. § 101 rejections.

The Examiner asserted that with respect to the 35 U.S.C. § 102 and 35 U.S.C. § 103 rejections, and Applicants' April 26, 2007 response and amendments, that such amendments will not be entered. Applicants respectfully assert that this is in error, since the December 21, 2007 Office Action is a non-final action, permitting applicants to make claim amendments and add new claims. Thus, for example, Applicants respectfully assert that new claims 63-68 submitted with the April 26, 2007 response must be examined by the Examiner.

I. REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-7, 9-16 and 18 stand rejected under 35 § 102(e) as being anticipated by *Pool et al.* (U.S. Patent No. 6,460,020). In response, Applicants respectfully traverse these rejections. It is noted that these § 102 rejections were made by the Appeal Board in their Decision On Appeal, mailed February 28, 2007. Applicants responded to those rejections in the Amendment filed April 26, 2007. Applicants incorporate by reference their response and arguments filed in such an Amendment dated April 26, 2007.

Moreover, since *Pool* has been utilized by the previous Examiner and the Appeal Board in various forms and combinations of rejections during the prosecution of this application, Applicants hereby incorporate by reference all of their previous arguments made with respect to the application of the *Pool* reference as prior art, namely the following responses:

- Amendment Under 37 C.F.R. § 1.111, filed February 7, 2003
- Fourth Amendment Under 37 C.F.R. § 1.111, filed September 8, 2003
- Appeal Brief filed April 30, 2004
- Reply Brief filed November 15, 2005
- Amendment Under 37 C.F.R. § 41.50(b) filed April 26, 2007

These responses are also incorporated by reference for Applicants' arguments below in Section II.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 8 and 17, 23, 26, 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pool*. It is noted that the Examiner has rejected all of the remaining claims under § 103 also, even though such claims are not listed in this statement of rejection.

With respect to Claims 8 and 17, these were rejected specifically by the Appeal Board, and Applicants incorporate their response of April 26, 2007.

However, it is noted that the Examiner has specifically incorporated the exact language for rejecting all of these claims, including claims 8 and 17, under § 103 using a previous Examiner's assertions from the Office Action dated December 12, 2003. Again, Applicants

faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art." Many of these same claims, particularly the independent claims, have been previously rejected under 35 U.S.C. § 102(e) as anticipated by *Pool* in the Office Action having a mailing date of May 8, 2003. Applicants successfully traversed those rejections. In fact, that is why the Examiner resorted to combining *Pool* with the *Kroenke* reference. This "new grounds of rejection" provides no new arguments relative to the previous § 102 rejection based on *Pool*, and does not point out any clear error in that previous rejection. Applicants are dismayed that they now have to again address a rejection they previously successfully traversed.

Furthermore, those assertions and rejections used by that previous Examiner were traversed and appealed by Applicants. The Decision On Appeal specifically reversed those rejections. Applicants respectfully assert that it is improper for Applicants to now have to argue against the same assertions and arguments by Examiners that have previously been overturned.

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *Graham vs. John Deere Co.*, 383 US 1 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on the underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness.

With respect to claim 8, under the Board's and Examiner's interpretation of claim 1, the database would have to be the third database referred to in the last paragraph of column 6 of *Pool*. Since this database contains lookup tables of the harmonized international tariff tables and classification system, and since such a database would be static and not updateable, *Pool* cannot teach claim 8. Further, the Examiner has admitted that these claims are not disclosed in *Pool*, but instead makes an unsupported opinion that such claims are obvious. Applicants traverse such an assertion. Such an unsupported opinion by the Examiner cannot support *a prima facie* case of obviousness. Claim 26 is patentable for similar reasons as claim 8.

With respect to claim 17, the foregoing arguments with respect to claim 8 are also applicable. Furthermore, Applicants respectfully assert that the Examiner must interpret claim 17 under *In re Donaldson*. MPEP § 2181.

With respect to claim 19, the Examiner's reasoning in producing the rejection is in error. The Examiner asserts that the server recited in claim 19 reads on the website described in column 3, lines 41-44. This is not possible. The invention described in *Pool* involves a customer accessing a website that runs the international transaction program described in *Pool*. Column 3, lines 40-42. This program accesses the third database to arrive at a commodity code as described in column 6, lines 51-67.

In conjunction with the server, this server running the international transaction program does not reside on the same server as the one containing the third database. In fact, *Pool* specifically teaches that this third database and the other databases accessed by the transaction program are external databases. Column 3, line 67. Furthermore, claim 19 specifically recites that the server hosts the database of product identifiers and corresponding import/export transaction information. Since such a server in accordance with the Examiner's interpretation is the third database, it cannot be that the server in claim 19 reads on the website of column 3, lines 41-44, since this server, under the Examiner's interpretation, would have to be containing the third database, which under the *Pool* disclosure is a database that is external to the server running to international transaction program. Therefore, Applicants' server in claim 19 does not read on the website of column 3, lines 41-44. In fact, the Examiner admits in the rejection that the first computer recited in claim 19 is the computer that operates the international transaction system. This is the computer described in column 3, lines 41-44.

Further, the Examiner has asserted that Applicants' computer reads on the customer's computer in *Pool*. Applicants respectfully disagree, since there is no disclosure within *Pool* that the customer's computer described in *Pool* is operable for accessing the data record over the Internet wherein the data record includes the import/export transaction information corresponding to the at least one product identifier.

Yet still further, claim 19 recites a program operable for matching the at least one product identifier with a product identifier contained in the database of product identifiers. There is no disclosure within *Pool* of a program that performs such a matching process. All that is disclosed in the last paragraph of column 6 is a manual lookup by the customer accessing the third database. There is no disclosure or any suggestion of a program for performing such a matching process.

With respect to claim 21, the Examiner has asserted that it would have been obvious for the vender of *Pool* to access the system via a website as it is not uncommon for many websites to have areas of the site sectioned off according to the information contained therein, such as when there are icons indicating "wholesalers" and "retailers," as *Pool* teaches that the system is accessible by a website. Applicants respectfully traverse this assertion by the Examiner, since the Examiner has failed to support this obviousness determination with any objective evidence.

Claim 22 recites that the data record is transformed into a customs report for transmittal to a customs entity. The language cited by the Examiner in column 10, lines 22-27 of *Pool* does not disclose such a claim limitation. This language teaches that a title or commercial invoice is created once electronic funds are transferred to a vendor from a local clearinghouse, wherein the vendor will utilize a connection to the transaction system to generate such an electronic title or commercial invoice. This language does not teach or disclose that such a commercial invoice includes import/export transaction information corresponding to the at least one product identifier.

Claim 23 is patentable over the cited prior art for the same reasons as given above with respect to claim 8. Further, *Pool* does not teach a program for updating the third database.

With respect to claims 24 and 25, the Examiner has asserted that the third programming steps read on the second user of the third database. This is not possible. The third programming steps recited in claim 24 are programming steps within a computer program product adaptable for storage on a computer readable medium. A user, or person, is not adaptable for storage on a computer readable medium.

Claims 24 and 25 are also patentable under the same reasoning as given above with respect to claim 19.

The arguments given above with respect to claim 8 are also applicable with respect to claim 26. Furthermore, there is no teaching within *Pool* that establishes a third web page, accessible by a third user at a third terminal coupled to the Internet using a web browser, that permits the third user to update the product identifiers and corresponding tariff classifications in the third database. In fact, the third database disclosed in *Pool* is not accessible to a user over the Internet using a web browser so that such a user could change the commodity codes stated therein.

With respect to the rejection of claims 27-28, the Examiner has asserted that one should see column 5, lines 2-58. No language within column 5 teaches that the product identifier is unique to a particular company. Nor is there any language within column 5 or anywhere else in *Pool* that the import/export transaction is associated with a particular company. In fact, the Examiner has admitted that *Pool* does not specifically disclose these claim limitations. Yet still further, nowhere within *Pool* is it taught or disclosed that the database of product identifiers and tariff classification information is customized on a per customer basis to ensure that the matching of the product identifiers with the tariff classification numbers is in compliance with local customs regulations.

The Examiner takes Official Notice that it is old and well-known in the financial and transactional arts to assign company unique part numbers or product ID numbers to specific products, as well as associating identifiable transactions with specific companies. Applicants respectfully traverse such an assertion, thus requiring the Examiner to support her Official Notice with objective evidence.

Claim 30 is patentable over *Pool* for reasons given previously with respect to claim 1. Claim 30 recites that the matching step results in the tariff classification information being assigned to the product identifier included in the invoice data. Since the Examiner has equated the product identifier with a commodity code, using such an interpretation claim 30 would recite that the matching step results in the commodity code being assigned to the commodity code

the product identifier with a commodity code, using such an interpretation claim 30 would recite that the matching step results in the commodity code being assigned to the commodity code included in the invoice data. Since this is not logical, it is clear that *Pool* does not teach claim 30.

With respect to claim 31, the same arguments given above with respect to claim 8 are also applicable. Furthermore, the Examiner has admitted that the language within claim 31 that states that the modifying step is performed "to ensure an accuracy of associations between the product identifiers and corresponding tariff classification information," is not disclosed in the reference. Instead, all the Examiner asserts is that it would have been obvious to one of ordinary skill in the database arts to update product information because it provides a powerful tool for organizing and updating products, etc. The problem with such an assertion is that it is not supported with any objective evidence. Nor, does such an assertion by the Examiner address the specific claim language of claim 31.

Claim 32 is also not disclosed by *Pool* under the Examiner's interpretation, since the invoice data inputted does not already include a commodity code as taught by *Pool*, since the third database is being accessed to arrive at the commodity code. Therefore, it does not make sense under the Examiner's interpretation for invoice data, which is transferred from the first terminal to the database, to list each product identified with a product identifier.

With respect to claim 34, the order disclosed in *Pool* is not the same as a customer entry report.

With respect to claims 38, 50 and 55, *Pool* does not teach wherein the database of product identifiers and tariff classification information is customized on a per customer basis to ensure that the matching of the product identifiers with the tariff classification numbers is in compliance with local customs regulations. Such compliance is nowhere to be found anywhere within *Pool*. The Examiner's rejection is without any objective supporting, amounting solely to her subjective opinion.

Claim 39 specifically recites that at least one product identifier is unique to a particular company. The commodity code disclosed in *Pool* is not unique to a particular company. Again,

With respect to claim 42, it is impossible for *Pool* to disclose the limitations recited in claim 42, since under the Examiner's interpretation that the commodity code is the same as the product identifier, in *Pool* if there was a matching process, essentially the commodity code would be assigned to the commodity code, which does not make any sense. That is because in *Pool*, a product type is used to manually look up a commodity code, wherein the product type is provided over the network connection to the third database. In the present invention, the product identifier is sent over a network connection where the matching program assigns import/export transaction information to the product identifier. There is no matching program disclosed in *Pool*.

Claim 43 is patentable over the cited prior art for the same reasons as given above with respect to claim 31. Furthermore, the Examiner has not in any way addressed the limitation that a program is operable for modifying the database to ensure legal compliance of associations between the product identifiers and corresponding import/export transaction information. Yet still further, nowhere within *Pool* is such a limitation taught or disclosed.

Claim 52 is patentable over the cited prior art for reasons similarly as given above with respect to claim 43.

Claim 55 is patentable over the cited prior art for reasons similarly as given above with respect to claim 52.

Claim 44 is not disclosed by *Pool*, since the Examiner has interpreted the product identifier recited in the claims as being the same as the commodity code. As a result, under the Examiner's interpretation, if the invoice data was sent over to the third database, it would naturally not have the commodity code, since that is what is retrieved from the third database. As a result, it is impossible for *Pool* to teach that the invoice data list products to be imported/exported, and each product is identified with a product identifier, since the invoice data, under the Examiner's interpretation, does not yet have the commodity code, since that is retrieved from the third database at a later time.

With respect to claim 53, the Examiner has not in any way addressed the step of "facilitating passage of the products through the country's customs office using the master report

created as a result of the comparing step trade." For this reason alone, the Examiner has failed to prove a *prima facie* case of anticipation. Additionally, nowhere within *Pool* is this step taught or disclosed. All that is disclosed in columns 11 and 12 is that the electronic title or commercial invoice can be in electronic format and transmitted along with a packing list to a customs department. This is not the same as creating a master report using the customs enter report where the product numbers and the invoice are each assigned a harmonized tariff number. In rejecting claim 53, the Examiner has merely asserted that the steps of claim 53 read on the purpose of the system of *Pool*. This is not a proper rejection, since it does not in any way cite specific objective language within *Pool* that teaches these claim limitations.

Claim 55 recites maintaining compliance of the database with current tariff regulations. *Pool* does not in any way teach such a step.

Claims 56-59 are patentable for the same reasons as given above with respect to claims 51 and 53.

Claim 61 is patentable over the cited prior art for similar reasons as given above with respect to claims 1, 19, 24, 53 and 56.

Claim 62 is patentable over the cited prior art for the same reasons as given above with respect to claims 1, 19, 24, 53, 56, 27, 36, 39, 46 and 51.

In conclusion, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in rejecting all of the foregoing claims.

IV. CONCLUSION

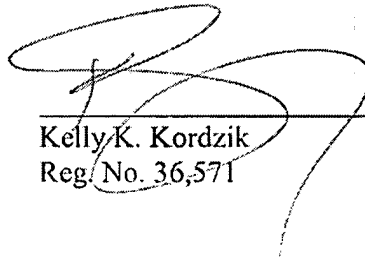
We believe there to be no fee(s) due at this time, however, if we have calculated incorrectly, please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 22543-002001.

Applicant : Thompson et al.
Serial No. : 09/576,462
Filed : May 23, 2000
Page : 24 of 24

Attorney's Docket No.: 22543-002001

Respectfully submitted,

Date: June 21, 2008



Kelly K. Kordzik
Reg. No. 36,571

Fish & Richardson P.C.
One Congress Plaza
Suite 810
111 Congress Avenue
Austin, TX 78701
Telephone: (512) 472-5070
Facsimile: (512) 320-8935